

REMARKS

Claim 8 has been amended. Claims 8-14 are now pending. Claims 8-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,182,553 ("Kung") in view of U.S. Patent No. 5,943,611 ("Molne"). Applicants respectfully request the Examiner to reconsider the above-captioned application in view of the above amendment and the following remarks.

I. CLAIMS 8-14 ARE NOT BY THE COMBINATION OF KUNG & MOLNE

Claims 8-14 stand rejected under 35 U.S.C. § 103 (a) as being rendered obvious by the combination of Kung and Molne. In support of the rejection, the Examiner notes that while "Kung does not explicitly disclose operating instructions that are able to be acoustically displayed via an output device," "in a similar field of endeavor, Molne is evidence of stored audible prompting instructions." It is respectfully submitted that the pending claims are not rendered obvious by Kung and Molne for at least the following reasons.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), not only must the prior art teach or suggest each element of the claim, the prior art must also suggest combining the elements in the manner contemplated by the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F. 2d 931, 934 (Fed. Cir. 1990); In re Bond, 910 F. 2d 831, 834 (Fed. Cir. 1990). The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. The Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. See M.P.E.P. §2143. Applicant respectfully submits that neither of these criteria for obviousness are met here.

As amended, claim 8 recites a "broadcast radio receiver set" that has "a memory for storing operating instructions that are capable of being retrieved, through input selection, in any desired section, and that are able to be at least acoustically displayed via an output device."

First, there is simply no motivation or suggestion to combine the teachings of Kung with the teachings of Molne. While the Examiner states that the combination would have been obvious because such combination would provide “the user with an additional option other than to display the instructions,” there is simply no suggestion in Kung and Molne that such an additional option is desirable for the communications receiver disclosed in Kung. Furthermore, while the Examiner contends that the fields of Kung and Molne are “similar,” it is simply illogical to suggest that acoustic-prompt technology contained in a cellular phone as disclosed in Molne is similar to the visual-display capability of a communications receiver as disclosed in Kung. It should be noted that Molne teaches audio prompt for the cellular-phone user to input certain search criteria. While it may be logical for a cellular phone to have the capability to deliver acoustic prompt as in Molne, it is simply illogical to incorporate an acoustic-prompt capability for requesting search information from a user of a communications receiver as disclosed in Kung. In view of the above, it is respectfully submitted that the combination asserted by the Examiner is not supported by the applied references, and the suggested combination is insufficient to support the obviousness rejection of claim 8.

Even if one assumed that there were some motivation to make the combination asserted by the Examiner, the suggested combination would still fail to approximate the claimed invention. As noted above, claim 8 recites a “broadcast radio receiver set” that has “a memory for storing **operating instructions** that are capable of being retrieved . . . and that are able to be at least acoustically displayed via an output device.” Molne discloses **audio prompting** of a user of a cell phone **to enter search criteria**; Molne does not provide acoustic **operating instructions**. This is a fundamental difference, because operating instructions provide the user with information which is independent of the state of the device, while the user prompt depends on the instantaneous state of the device and only provides information regarding what the next operating step is (to enter search criteria). For these reasons, the suggested combination of Kung and Molne would not render the subject matter of claim 8 obvious, and claim 8 is allowable over the applied references.

Claims 9-14, which depend from allowable claim 8, are similarly allowable by virtue of their dependence on allowable claim 8.

In view of the foregoing, it is respectfully requested that the rejection of claims 8-14 be withdrawn.

II. CONCLUSION

In light of the foregoing, applicants respectfully submit that all pending claims are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,
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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the claims:

Claim 8 has been amended as follows:

8 (Amended) A broadcast radio receiver set, comprising:

a memory for storing operating instructions that are capable of being retrieved, through input selection, in any desired sections, and that are able to be at least acoustically displayed via an output device.